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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/316,430

Applicant(s)

KATZ, RONALD A.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The request filed on 03/11/2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/316430 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2 The amendment, paper # 14, filed on 03/20/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material (SEE PAGES 2 AND 3 OF THE AMENDMENT) which is not supported by the original disclosure is as analyzed below:

(i) Request to insert " COMMUNICATION SYSTEM " in FIG.2 broadens the scope to include additional communication systems, other than the presently specified "dial-up public telephone system ", such as cable television network, Internet telephone, wireless, etc. which are not supported by the disclosure.

(ii) On page 6, line 13, in the request to change "effectively prevents " to –also avoids – the term "also" broadens the scope of the system, which, at present is directed to effectively prevent or effectively avoid the information overloading by properly directing communication traffic between the already select/designated/specified individual buyers of a company and the already select/designated/specified vendors (see at least page 41, paragraph 0127, lines 27-32, " Returning to the routine situation, as indicated above, each buyer and vendor is associated with specific merchandise codes.....merchandise codes not only facilitate and expedite communication..." explicitly teaches that both selected buyers and vendors are associated with

a common merchandise code. FIG.9, and page 44, paragraph 0135, lines 23-35 explicitly discloses that the buyer specifies this merchandise code in the request for proposal before the request reaches selectivity logic 47/central traffic control system TIS and the merchandise code itself is indicative of the selected vendor and also of the fact that mere routing of the request for purchase communication is carried out by the selectivity logic 47/TIS and not filtering of unspecified vendors to select vendors based upon conditions stated in the request.).

(iii) In the request to change on page 11, line 3, after "illustrating " insert—a form of — at line 3 and cancel "central " and at line 4, cancel "scheduling and routing" broadens the scope of functions of the central traffic control system TIS, which, at present is centrally directed to scheduling and routing the communication traffic between the individual select/designated/specified buyers of a company and the already select/designated/specified vendors, to effectively prevent or effectively avoid the overloading. See also 2 (ii) for detailed analysis.

(iv) In the request to insert "filtering " on page 19, line 2, after "traffic, " amounts to new matter. The traffic control system TIS is a switching call center, which, controls and routs the calls/communication traffic from individual buyers of a company to the designated vendors based upon identification data such as DNIS, ANI, "800" lines, merchandise codes already stored in a database (see at least, page 7, para 0017, line 25-page 8, para 007, line 6, page 16, para 0053, lines 31-35, page 18, paragraph 0059, lines 29-35) to avoid information overload. The disclosure does not show that TIS carries out filtering of vendors but it teaches selective routing of calls/communication traffic including requests for proposals between the individual select/designated/ specified buyers of a company and the already select/designated/specified vendors, to effectively prevent or effectively avoid the overloading (see at least page 41, paragraph 0127, lines 27-32, " Returning to the routine situation, as indicated above, each buyer and vendor is associated with specific merchandise codes.....merchandise codes not only

facilitate and expedite communication..." explicitly teaches that both selected buyers and vendors are associated with a common merchandise code. FIG.9, and page 44, paragraph 0135, lines 23-35 explicitly discloses that the buyer specifies this merchandise code in the request for proposal before the request reaches selectivity logic 47/central traffic control system TIS and the merchandise code itself is indicative of the selected vendor and also of the fact that mere routing of the request for purchase communication is carried out by the selectivity logic 47/TIS and not filtering of unspecified vendors to select vendors based upon conditions stated in the request.). .

(v) The request to insert --filtering structure to provide a select group is-- at line 4, after "at 47" and --also--at line 7, are analyzed similarly as in 2 (ii) and (iv) above respectively and constitute new matter.

(vi) The request to insert --and-after "determinations" on page 33, line 4 constitutes new matter and will result in changing the present invention. The disclosure explicitly states that the merchandising codes, along with DNIS, and ANI are used as identification data in the request for proposal to indicate the selected vendor to which the request for proposal should go and by the selectivity logic 47 to enhance the selection of calls/communication between buyers and vendors to assist TIS to properly direct communications between buyers and vendors to prevent information overload only (see at least page 23-24, paragraph 0076, page 37, paragraph 01115. Page 41, paragraph 0127, lines 27-32, " Returning to the routine situation, as indicated above, each buyer and vendor is associated with specific merchandise codes.....merchandise codes not only facilitate and expedite communication..." explicitly teaches that both selected buyers and vendors are associated with a common merchandise code. FIG.9, and page 44, paragraph 0135, lines 23-35 explicitly discloses that the buyer specifies this merchandise code in the request for proposal before the request reaches selectivity logic 47/central traffic control system

TIS and the merchandise code itself is indicative of the selected vendor and also of the fact that mere routing of the request for purchase communication is carried out by the selectivity logic 47/TIS and not filtering of unspecified vendors to select vendors based upon conditions stated in the request.). Similarly, the request to insert--enable-- in place of "enhance" and for inserting--help--after communication in lines 9-10 on page 37, changes the present cope of the disclosure. As explained above TIS uses DNIS, ANI signals to identify and rout calls/communication traffic to the designated recipients and using merchandising codes to prevent information overload further enhances this proper routing.

(vii) The request to insert - -For, as indicated above.....that comport to a request— on page 41, line 10 constitutes a new matter. The term " that comport to a request" broadens the present scope of disclosure. The tests for recipients, in the disclosure, are directed to the selection and routing of calls/communication, on the basis of merchandising codes, along with DNIS, and ANI signals to properly direct calls/communications between buyers and vendors to prevent information overload and wrong exchange of information (see at least page 37, paragraph 0114-page 42, paragraph 0126). By adding the term " that comport to a request" can imply more than what is presently disclosed in the specification. See also details in 2 (ii) above.

(viii) The request to insert - -select-- on page 45, line 2 constitutes a new matter. Presently, the disclosure does not teach to select vendors for sending notices as the vendors are already designated/selected/specified (see detail analysis in 2 (ii)).

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

3. Applicant's arguments filed on March 11, 2003 have been fully considered but they are not persuasive as analyzed below.

3.1. With respect to the applicant's remarks and analysis interpreting that US112 paragraph 6 is not applicable for "filter means", the examiner disagrees for following reasons:

The claim language of ' 328 patent satisfies the MPEP guidelines to invoke USC 112, paragraph 6 for prior art rejection relating to "filter means " limitations. See MPEP 2181 [R-1] Identifying a 35 U.S.C. 112, Sixth Paragraph Limitation. This section sets forth guidelines for the examination of 35 U.S.C. 112, sixth paragraph "means or step plus function" limitations in a claim. LANGUAGE FALLING WITHIN 35 U.S.C. 112, SIXTH PARAGRAPHA claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for " or "step for ";
- (B) the "means for " or "step for " must be modified by functional language; and
- (C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function.

These guidelines are based on the Office's current understanding of the law and are believed to be fully consistent with binding precedent of the Supreme Court, the Federal Circuit and the Federal Circuit's predecessor courts. The Court of Appeals for the Federal Circuit, in its en banc decision *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), decided that a "means-or-step-plus-function" limitation should be interpreted in a manner different than patent examining practice had previously dictated. The Donaldson decision affects only the manner in which the scope of a "means or step plus function" limitation in accordance with 35 U.S.C. 112, sixth paragraph, is interpreted during examination. When making a determination of patentability under 35 U.S.C. 102 or 103, past practice was to interpret a "means or step plus function" limitation by giving it the "broadest reasonable interpretation." Under the PTO's long-standing practice this meant interpreting such a limitation as reading on

any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification. However, in *Donaldson*, the Federal Circuit stated: Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

See also MPEP 2114 [R-1] Apparatus and Article Claims — Functional Language.

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART >While features of an apparatus may be recited either structurally or functionally, claims< directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). **A PRIOR ART DEVICE CAN PERFORM ALL THE FUNCTIONS OF THE APPARATUS CLAIM AND STILL NOT ANTICIPATE THE CLAIM.** Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. It should be noted, however, that means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). See also *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in

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the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

In view of above, since the "filter means" claim language invokes USC 112, paragraph 6, it is incumbent that that the disclosure of the instant application should have the same structural elements for "filter means" as disclosed in "328 patent. As explained in the earlier Final Office action, paper # 11, and again presented below, the structural elements of the "filter means " are different in "328 patent than disclosed in specification of the instant application. With reference to the applicant's arguments (see amendment page 5, line 19-page 11, line 5) to prove that the structural elements of the instant application are same as disclosed in '328 patent, the examiner does not agree and the following analysis also disposes these arguments presented by the applicant.

(i) In the instant application the vendor is already selected/designated by the buyer when he forwards the request, and this request for proposal with the already designated/selected vendor from buyer reaches the selectivity logic 47 in the TIS-the filter means claimed by the applicant (see amendment page 9, line 15-page 10, line 2, "*...Functionally the operation is performed by the central traffic control system TIS.....the selectivity logic 47....and occasionally the Unit P28* "), it enhances the selection of calls/communication between buyers and vendors based upon data such as DNIS, AIN and numerical merchandising codes like 47000 , to assist TIS, to determine and properly direct communications between already selected/designated buyers and designated vendors to prevent information overload only (see at least page 23-24, paragraph 0076, page 37, paragraph 01115. Page 41, paragraph 0127, lines 27-32, " Returning to the routine situation, as indicated above, each buyer and vendor is associated with specific merchandise codes.....merchandise codes not only facilitate and expedite communication..." explicitly teaches that both selected buyers and vendors are associated with a common

merchandise code. FIG.9, and page 44, paragraph 0135, lines 23-35 explicitly discloses that the buyer specifies this merchandise code in the request for proposal before the request reaches selectivity logic 47/central traffic control system TIS and the merchandise code itself is indicative of the selected vendor and also of the fact that mere routing of the request for purchase communication is carried out by the selectivity logic 47/TIS and not filtering of unspecified vendors to select vendors based upon conditions stated in the request.). However, in '328 patent the request for quotation is not directed to any designated/selected/specified vendors but instead the RFQ is processed at the filter means to select from unspecified vendors based on the filter conditions defined in the said request (see '328 patent, col.5, lines 9-36).

(ii) In '328 patent the filtering criteria/conditions are :- if vendor is capable of quoting to RFQ, language, currency, business arrangements and a formula which prioritizes the vendors (see '328 patent, col.5, lines 9-36. In the instant application the selectivity logic 47 in the TIS-the filter means claimed by the applicant (see amendment page 9, line 15-page 10, line 2, *"...Functionally the operation is performed by the central traffic control system TIS.....the selectivity logic 47....and occasionally the Unit P28)* does not use this filtering criteria and obviously because the vendors are already selected and designated. Instead the selectivity logic 47 enhances the selection of calls/communication between buyers and vendors based upon data such as DNIS, AIN and numerical merchandising codes like 47000, to assist TIS, to determine and properly direct communications between already selected/designated buyers and designated vendors to prevent information overload only (see at least page 23-24, paragraph 0076, page 37, paragraph 01115) selected/designated/specified vendor.

The objective of the system in the application is to facilitate selection of transmission of communications between already designated individual buyers and vendors to prevent

information overload (see at least disclosure, page 1, lines 21034, page 5, line 24-page 8, line 5) and does not disclose selecting vendors at the buyer's stage, as analyzed above.

3.2. With regards to the applicant's remarks (pages 4-11) for withdrawing rejection of claims 17-34 under USC 112, first paragraph, they have been fully considered and are not persuasive for reasons stated below:

With regards to claims 17-18, claim 19, claims 20-27, 28-31, and 32-34, the specification does not disclose (a) filter means for filtering the network members in said storage means to determine whichnetwork membersin accordance with pre-established conditions (b) that the filter conditions are set by the buyer and the vendor for selecting one or more appropriate vendors to send the buyer's request for proposals but instead the vendor is already selected/designated by the buyer when he forwards the request, (c) filter and broadcast means for receiving requests from said requestor to engage with unspecified vendor terminals, (d) filtering at filter means to ascertain a set of sellers in response to at least one request for proposal from one buyer, and (e) filtering said RFPs meeting a first set of filter conditions and filtering the accepted quotes from sellers meeting additional filter conditions set by vendors/filter means respectively. Instead, the specification teaches that the vendor is already selected/designated/specified by the buyer when he forwards the request, and this request for proposal with the already designated/selected vendor from buyer reaches the selectivity logic 47 in the TIS-the filter means claimed by the applicant (see amendment page 9, line 15-page 10, line 2, "...Functionally the operation is performed by the central traffic control system TIS.....the selectivity logic 47.....and occasionally the Unit P28"), which enhances the selection of calls/communication between buyers and vendors based upon data such as DNIS, AIN and numerical merchandising codes like 47000, to assist TIS, to determine and properly direct

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communications between already selected/designated/specified buyers and vendors to prevent information overload (see at least page 23-24, paragraph 0076, page 37, paragraph 01115. Further, Page 41, paragraph 0127, lines 27-32, " Returning to the routine situation, as indicated above, each buyer and vendor is associated with specific merchandise codes.....merchandise codes not only facilitate and expedite communication..." explicitly teaches that both selected buyers and vendors are associated with a common merchandise code. FIG.9, and page 44, paragraph 0135, lines 23-35 explicitly discloses that the buyer specifies this merchandise code in the request for proposal before the request reaches selectivity logic 47/central traffic control system TIS and the merchandise code itself is indicative of the selected vendor and also of the fact that mere routing of the request for purchase communication is carried out by the selectivity logic 47/TIS and not filtering of unspecified vendors to select vendors based upon conditions stated in the request.).

Claim Rejections - 35 USC § 112

4. Claims 17-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regards to claims 17-18, claim 19, claims 20-27, 28-31, and 32-34, the specification does not disclose (a) filter means for filtering the network members in said storage means to determine whichnetwork members ...in accordance with pre-established conditions (b) that the filter conditions are set by the buyer and the vendor for selecting one or more appropriate vendors to send the buyer's request for proposals but instead the vendor is already selected/designated by the buyer when he forwards the request, (c) filter and broadcast means

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for receiving requests from said requestor to engage with unspecified vendor terminals, (d) filtering at filter means to ascertain a set of sellers in response to at least one request for proposal from one buyer, and (e) filtering said RFPs meeting a first set of filter conditions and filtering the accepted quotes from sellers meeting additional filter conditions either by said vendor or filter means respectively. Instead, the specification teaches that the vendor is already selected/designated/specified by the buyer when he forwards the request, and this request for proposal with the already designated/selected vendor from buyer reaches the selectivity logic 47 in the TIS-the filter means claimed by the applicant (see amendment page 9, line 15-page 10, line 2, "...Functionally the operation is performed by the central traffic control system TIS.....the selectivity logic 47....and occasionally the Unit P28"), which enhances the selection of calls/communication between buyers and vendors based upon data such as DNIS, AIN and numerical merchandising codes like 47000, to assist TIS, to determine and properly direct communications between already selected/designated/specified buyers and vendors to prevent information overload (see at least page 23-24, paragraph 0076, page 37, paragraph 01115. Further, Page 41, paragraph 0127, lines 27-32, "Returning to the routine situation, as indicated above, each buyer and vendor is associated with specific merchandise codes.....merchandise codes not only facilitate and expedite communication..." explicitly teaches that both selected buyers and vendors are associated with a common merchandise code. FIG.9, and page 44, paragraph 0135, lines 23-35 explicitly discloses that the buyer specifies this merchandise code in the request for proposal before the request reaches selectivity logic 47/central traffic control system TIS and the merchandise code itself is indicative of the selected vendor and also of the fact that mere routing of the request for purchase communication is carried out by the selectivity logic 47/TIS and not filtering of unspecified vendors to select vendors based upon conditions stated in the request.).

5. Note: Prior art eligibility date. Since the subject-matter/limitation of the claims in the instant application, "filter means for filtering the network members based upon filter conditions" using a selectivity logic 47 is supported only by the co-pending application serial no. 08/189,405, filed on January 27, 1994 and now US Patent number 6,323,894, the prior art date earlier than January 27, 1994 will be eligible for art rejection.

Claim Rejections - 35 USC § 102

6. Claims 20-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Spiegelhoff et al. (US Patent number 5, 742, 931).

Note: In light of the above 35 U.S.C. 112 first paragraph rejection, the filter limitations of claim 20 *for engaging unspecified vendor terminals and for filtering said requests to determine with which vendor terminals said requests should be matched* are not supported by the specification. Thus only the limitations of claims 20-27 that are supported by the specification are being considered for examination.

Regarding claim 20, Spiegelhoff teaches a computerized system for engaging in transactions over a data network, said computerized system (col.3 line 62 to col.4 line 2, "... a computerized system is provided..." and col.4 lines 61-63, "Computer 22.... and will be electronically connected.... via modem, to the computers 24, 26,....) comprising:

a plurality of terminals, at least one of which being designated a requestor and others of which are designated vendor terminals (col.3 lines 62-65 and fig.1, "...an input request from the orderer.....selected wholesalers....". Note: Examiner has interpreted the orderer and the wholesales in the reference as buyer and vendors respectively.);

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filter and broadcast means (col.2 lines 23-39, "means for obtaining the informationfromthe warehouses.....by the means (i), and for selecting ...warehouses based on a predetermined criterion....) for receiving, over said data network, requests from said requestor to engage in transactions with unspecified vendor terminals (col.5 lines 25-28, "being linked to the computers of.....warehouses... ..receiving input requests....", and col.4 lines 54-60, " ...first computer 22connected... computer 24....computers 26,28....secondary warehouses 1,2 and "n"....". Note: Computer 22 refers to central computer system and elements 24,26,28, 30...the warehouses to unspecified vendor terminals.), and for filtering said requests to determine with which vendor terminals said requests should be matched (col.9 line 21 to col.12 line 25-the headings and contents under " Edit warehouse Routine", " Edit Freight/Rebate Charges Routine", and " Activate/ Deactivate Warehouse Routine" describing the filtering means and conditions. Note: Refer to subroutine 162 -col.9 lines 45-49, fig.7- for adding new warehouses and subroutine 180-col.10 lines 17-27, fig.8-for deleting warehouses as per the updated information on the warehouses-col.9 lines24-33. Refer routine 62, in fig.3 which permits to activate those warehouses only which can deliver items in the required time period and fulfill other reasons-col.11 line55-col.12 line 7.); and

means for matching said requests with vendor terminals which meet predetermined filter conditions for generating quotes (col. 3 lines 1-7, " ...obtaining information about an item from....warehouses.....to deliver the items based on a predetermined criterion" and col.9 line 21 to col.12 line 25-the headings and contents under " Edit warehouse Routine", " Edit Freight/Rebate Charges Routine", and " Activate/ Deactivate Warehouse Routine" describing the filtering means and conditions. Note: Refer to subroutine 162 -col.9 lines 45-49, fig.7- for adding new warehouses and subroutine 180-col.10 lines 17-27, fig.8-for deleting warehouses as per the updated information on the warehouses-col.9 lines24-33. Refer routine 62, in fig.3

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which permits to activate those warehouses only which can deliver items in the required time period and fulfill other reasons-col.11 line55-col.12 line 7.) from information contained in a database associated with said vendor terminals (col.5 lines 35-38, " ... computers of ... warehouses....storing a great deal of information...."), and for accepting said quotes from said vendor terminal, wherein the central database contains information that is insufficient to consummate the transaction (col.5 lines 16-24, " Data transfer...controlled by retailer's computer 22....transmission of data from the computer 22 to.....24....30 ... and extraction of data from ...24...30 to computer 22". Examiner has interpreted the retailer's computer 22's function that of the central computer and it does not contain sufficient information to consummate the transaction but it has to extract the data from vendor computers 24, 26, 28, 30.).

Regarding claim 21, Spiegelhoff discloses means for communicating responses from said vendor terminals to said filter and broadcast means (col. 5 lines 16-24, " ...computer 22 is electronically linked.....computers 24,26...to permit information to be conveyed back and forth between computer 22 and the warehouse computers...". Here warehouse pertains to the vendor and retailer computer to filter and broadcast means.) and means at said filter and broadcast means for communicating a selected set of said response to said requestor (col. 3 lines 1-7, " obtaining information about an item fromwarehousesselecting, via the first computer, oneat least two warehouses to deliver the item.....". Here, the first computer relates to filter and broadcast means and warehouses to vendor terminals. Further, it will be inherent in the system to deliver the items to the orderer (in the reference), who relates to the requestor.)

Regarding claim 22, Spiegelhoff teaches said transaction is a purchase and wherein the purchase may comprise a plurality of items (col.4 lines 2-5, " ...systemordering each of a high number of items....).

Regarding claim 23, Spiegelhoff discloses means for establishing communications between said filter and broadcast means and said vendor terminals which meet said filter conditions; and means for determining whether a quote for said transaction from a particular vendor terminal meeting said filter conditions should be sent to said requestor (col. 2 lines 20-39, "means for obtaining the information from..... the warehousesmeans for evaluating the information.....and for selecting one ofwarehouses....based on a predetermined criterion...).

Regarding claims 24-26, Spiegelhoff further suggests that said communications can be continuous or periodic (col. 4 line 61 to col. 5 line 2, "electronically connected ...via modem.....orvia diskette, hard copy, or any other mechanism for communication.") and initiated by said vendor terminal (col. 5 lines 16-20, " computer 22 is electronically linked..... 24,26,28....permit information to be conveyed back and forth between computer 22 and..warehouse computers.").

Regarding claim 27, Spiegelhoff also discloses means for automatically notifying a buyer when particular items meeting specified conditions become available from a seller (col. 2 lines 23-39, " ...the system include means....for conveying information about items to the orderer... .means for evaluating the information....selecting... warehousesbased on a predetermined condition....).

7. Claims 28 and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Shavit et al. (US Patent number 4,799, 156) hereinafter referred to as Shavit.

Note: In light of the above 35 U.S.C. 112 first paragraph rejection, the filter limitations of claim 28 *for filtering, at said filter means, the at least one request in order to ascertain a set of sellers potentially capable of supplying said goods or services* are not supported by the specification. Thus only the limitations of claims 28 and 30-31 that are supported by the specification are being considered for examination.

Regarding claim 28, Shavit teaches a method of purchasing goods or services over a network (see abstract) comprising the steps of:

communicating, over said data network, to a filter means (col. 2 lines 20-36, "a system is provided for interactive on-line electronic communications and processing of business transactions between....a plurality of sellers and a plurality of buyers....and a selected one of the plurality of sellers wherein one party to the transaction specially selects the other party ...".

Note: system 50 relates to filter means.), at least one request for a proposal from a potential buyer of said goods or services (col. 13 line 10, " A buyer may enter...one or more RFQs");

filtering, at said filter means, the at least one request in order to ascertain a set of sellers potentially capable of supplying said goods or services (col. 2 lines 25-36, " ... access means for interactive on-line transactions between one of the plurality of buyers and a selected one of the plurality of sellers.....specifically selects the other party..". Note: specifically selection of a party to the transaction relates to filtering to ascertain a set of sellers for supplying said goods or services. Shavit discloses that the transaction can take between more than two different users- col.2 lines 33-36- that is between a buyer and more than one sellers.); and

obtaining, from at least one of said potential sellers over a data network, quotes to supply said goods or services, and forwarding said quotes to said potential buyer (col.15 line 61-col.16 line 10, " ..system transmits RFQ to a supplier.....receive... a structured bidding file...it is communicated to the distributor's terminal..". Note: distributor relates to buyer. Also see

col.16 lines 54-60, "shipped can inter.....RFQ.....submit to one or more subscribing carriers.....bid can be received immediately...or shortly after), wherein at least part of the quote information is stored at a location remote from said filter means (col5. lines 20-42, " The system 50 permits users...buyers, sellers,at remote sites to conduct business transactions and communicate with databases.....from a variety of remote terminals...". Note: system 50 relates to filter means and seller's terminal a remote location from filter means.).

Regarding claim 30, Shavit discloses the step of each seller contacting said filter means at predetermined intervals and supplying bids in response to any requests for proposal that have arrived at said filtering means (col.6 line 62-col.7 line1, ".,,system 50 supports for batch communications.....buyers and sellerscommunications.with the mailbox owner may be done periodically and on a batch basis....") and that was determined, by the filter means, to be a request for proposal for goods or services which said each seller is potentially capable of supplying (col. 2 lines 25-36, " ...access means for interactive on-line transactions between one of the plurality of buyers and a selected one of the plurality of sellers.....specifically selects the other party..". Note: specifically selection of a party to the transaction relates to filtering to ascertain a set of sellers for supplying said goods or services. Shavit discloses that the transaction can take between more than two different users-col.2 lines 33-36- that is between a buyer and more than one sellers.).

Regarding claim 31, Shavit further discloses the step of automatically and periodically supplying the filter means (col. 7 lines 43-46, "Communications....interactive ... a continuous flow ...or batch involving periodic transfer of information or transaction...."), with information sufficient to assemble a bid and sending the bid to said potential buyer via e-mail (col. 11 lines 52-67, " the buyer is advised about any outstanding incoming mail....incoming bids.....bids, shipping advisories ..transferred to the user's computer...").

Claim Rejections - 35 USC § 103

8. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit (US Patent number 4,799, 156) in view of Maloney et al. (US Patent 5,684,870), hereinafter, referred to as Maloney.

Note: In light of the above 35 U.S.C. 112 first paragraph rejection, the limitations of claims 17-19, “ *filter means for filtering the network members in said storage means to determine whichnetwork members ...in accordance with pre-established conditions and that the filter conditions are set by the buyer and the vendor for selecting one or more appropriate vendors to send the buyer's request for proposals but instead the vendor is already selected/designated by the buyer when he forwards the request* are not supported by the specification. Thus only the limitations of claims 17-19 that are supported by the specifications are being considered for examination.

Regarding claims 17 –18, Shavit teaches a computerized system for forming a computer based communications network of network members inclusive of network buyers and or network vendors for processing requests for proposal for goods and services through at least one central processing unit (col. 5 lines 15-65, figs. 1 and 2, “ ...market management system 50....” is related to central processing unit including:

operating system software for controlling the central processing unit (col.2 lines 9-15, “ ..to provide a novel ...processing system permitting controlled on-line ...electronic access....operational and commercial information.....”), said network members being remotely located from said central processing unit and connected thereto via a communications channel (col.5 lines 15-65, “system 50 permits users.....at remote sites....and communicate....), the

central processing unit being coupled to a storage means containing identification of the network members (see abstract, " ...system includes a data base which contains user information.....validation procedure to permit business transactions....");

means for network buyers to generate request for proposal for goods and/or services (col. 12 lines 58-60, " ...distributor's menu may present.....request for quotation (RFQ)....." here distributor relates to buyer of goods from supplier, and col.15 lines 4-6, "....distributor's computer application...generate. ...RFQs',....");

means for transmitting said request for proposal to said central processing unit (col.7 lines 55-57, " ..incoming requests for quotation (RFQ) from ...customer..." and col. 15 lines 4-11, " ..the system 50 receives a transaction from one computer....", transaction here refers to RFQ);

means for broadcasting said request for proposal to the network members (col. 15 lines 63-64, " ...system transmits an RFQ to a supplier.....");

means for responding to the generator of said request with either a response from the selected network members (col. 15 lines 45-47, " ...system 50..allows the supplier to provide its customers with an on-line interactive sales service providing immediate quotations... information. ") or with a list of said selected members for said generator of said request to establish independent communication (col. 6 lines 39-43, " This also permits the system 50 to provide buyersreliable and consistent way of reaching multiple sources).

Additionally, Shavit teaches that the said network members communicate/send request for quotations via central processing system using public telephone networks, using computing logic, the location database, (col.5 lines 39-65, " ... The communication links 74a-8i may be of any of a wide variety of network services, such as public telephone networks,....., and col.7, lines 19-57). Shavit does not disclose filter means for filtering the network members in said

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storage means to determine which network members are to receive said request for proposal based upon filter conditions set up by the network buyer in said request for proposal or by the central processing unit in accordance with pre-established conditions. Note: the filter means in the specification pertains to selectivity logic 47/TIS (see amendment page 9, line 15-page 10, line 2, "...*Functionally the operation is performed by the central traffic control system TIS.....the selectivity logic 47....and occasionally the Unit P28*"), which switches calls/communication between buyers and vendors based upon numerical data such as DNIS, AIN, to already selected/designated/specified buyers and vendors. See details in 2 (ii) and (iv) above. In view of this note, Maloney, like in the application, discloses filter means for filtering the network members in said storage means to determine which network members are to receive said request for proposal based upon filter conditions set up by the network buyer in said request for proposal or by the central processing unit in accordance with pre-established conditions. Maloney discloses the selection of calls/communication between buyers and vendors based upon data such as DNIS, to assist central station to determine and properly direct communications between already selected/designated/specified buyers and vendors (see at least Maloney, col.2, line 40-col.4, line 12, col.4, line 42-col.6, line 55, col.7, line 45-col.8, line 33, col.8, line 67-col.11, line 27. It would have been obvious for an ordinary person of skill in the art at the time of invention to use Maloney's concept of routing calls because that will enable the system to direct the calls/requests from buyers to the recipients' call centers/sites based upon identification data as explicitly disclosed in Maloney (see at least, col.1, lines 25-31, col.2, lines 30-37, col.3, lines 37-64, col.10, lines 32-44).

Regarding claim 19, the limitations correspond to the system claims 17-18 and are therefore analyzed and rejected using the same rationale.

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9. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit as applied to claim 28 above, and further in view of Maloney

Regarding claim 29, Shavit teaches a method of purchasing goods or services over a data network as disclosed and analyzed in claim 28 above. Further, the limitation recited in claim 29 is covered in claim 17 and, therefore, analyzed and rejected in view of Shavit/Maloney using the same rationale of claim 17.

10 Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit (US Patent number 4,799, 156) in view of Maloney.

Note: In light of the above 35 U.S.C. 112 first paragraph rejection, the limitations of claims 32-34 *for filtering said RFPs so that only sellers meeting a first set of filter conditions receive said RFPs and accepting quotes from sellers meeting said first set of filter conditions, and filtering said quotes so that only quotes meeting additional filter conditions set by vendors/filter means are sent to a buyer requesting said quotes* are not supported by the specification. Thus only the limitations of claims 32-34 that are supported by the specifications are being considered for examination. As analyzed above in 2 (ii) and (iv) above the filter means in the specification pertains to selectivity logic 47/TIS (see amendment page 9, line 15-page 10, line 2, "...Functionally the operation is performed by the central traffic control system TIS.....the selectivity logic 47....and occasionally the Unit P28"), which switches calls/communication between buyers and vendors based upon numerical data such as DNIS, AIN, to already selected/designated/specified buyers and vendors. Specification does not disclose any additional filter conditions relating to the same request for proposal sent by a buyer.

Regarding claims 32-34, Shavit teaches a method of matching buyers of goods and services with sellers of goods and services over a data network (col. 5 lines 15-65, figs. 1 and 2) comprising the steps of:

communicating, from buyers to a central processing unit, requests for proposals (RFPs) (col.7 lines 55-57, " ..incoming requests for quotation (RFQ) from ...customer..." and col. 15 lines 4-11, " ..the system 50 receives a transaction from one computer....", transaction here refers to RFQ); and

transmitting, to remotely located seller databases, RFPs (col. 15 lines 63-64, " ... system transmits an RFQ to a supplier....." and col. 6 lines 39-43, " This also permits the system 50 to provide buyers with a reliablemultiple sources to shop...").

Shavit does not teach about filtering conditions set up by vendor/filter means. However, this limitation is already covered in claim 17 and is therefore analyzed and rejected using the same rational as in claim 17 in view of Shavit/Maloney.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US patents 5,583,928 to Tester et al. and 5,384,841 to Adams et al. disclose calls/communication control traffic system controlling and regulating the calls/communication traffic and properly directing them to the recipients based upon identification data similar to selectivity logic 47 of TIS in the instant application.

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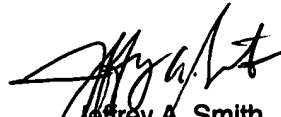
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
May 16, 2003


Jeffrey A. Smith
Primary Examiner